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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,949	01/28/2002	George M. Bernard	TER2-BR06	4624

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EXAMINER

HESS, DOUGLAS A

ART UNIT PAPER NUMBER

3651

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/058,949

Applicant(s)
Bernard et al.

Examiner
Douglas Hess

Art Unit
3651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 21, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) 30-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 28, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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1. Claims 30-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 8.

2. The drawings are objected to because in drawing figure 5, it appears reference numerals 89 and 91 should be reversed based on the description in the specification. It appears "91" depicts the "hopper" not the "chute". Likewise, it appears "89" depicts the "chute" not the "hopper". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's own admission (figures 2 and 4) in view of Hoffmann et al. And further in view of Kay.

The applicant teaches that a stacker receiver is well known in figure 2. Kay (see attached marked up cover sheet of Kay) teaches a mobile conveyor module with a hopper and chute at opposite ends on steerable rolling stock (crawler tracks capable of steering through 180 degrees) and Hoffmann et al.(see attached marked up copy of figure 1 of Hoffmann et al.) teach a mobile tripper module as currently claimed including a receiving hopper and discharge chute, steerable self powered drive unit and a span of a certain length. It would have been obvious to combine the three devices as disclosed above in any number of combinations (as applicant has in the independent claims 1, 10, and 19) with respect to each other, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

RE claims 2, 20, and 21, as stated above, Kay, Hoffmann et al, and applicants own admission disclose the claimed subject matter except for having a second or a plurality of mobile conveyor modules. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to duplicate any of the well known conveyors in order to meet the needs of the conveying reaches as need for the particular job at hand, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. V. Bemis Co., 193 USPQ 8.

RE claims 5, 9, 14, 17, 25 and 29, involving the length of the conveying sections, It would have been an obvious matter of design choice to provide any particular conveyor length necessary to perform the job at hand, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill inn the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

UK Patent Application 2 179 617 shows an extremely long conveyor in his figure 1.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hess whose telephone number is (703) 308-3428. The examiner can normally be reached on Monday-Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (703) 308-2560.

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The fax phone number for the organization where this application or proceeding is assigned is (703)-308-0552.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Hess
September 4, 2003


DOUGLAS HESS
PRIMARY EXAMINER
9-4-03